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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,322	04/12/2000	Albert L. Donaldson	110768-00102	6262
27557	7590	11/18/2005	EXAMINER	
BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			WINDER, PATRICE L	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,322

Applicant(s)

DONALDSON, ALBERT L.

Examiner

Patrice Winder

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44,45,47-52,54-60,63-75 and 78-86 is/are pending in the application.
- 4a) Of the above claim(s) 46-51,53-57,61-72,76-85 and 91-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44,45,52,58-60,73-75 and 86-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 91-96 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The claims are drawn to Invention V of the election/restriction mailed on December 12, 2004. Applicant elected to Invention VIII.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 91-96 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 73-75 are rejected under 35 U.S.C. 101 because claims 73-75 are not limited to tangible embodiments. In view of Applicant's disclosure, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., an article of manufacture) and intangible embodiments (e.g., a computer-readable medium having stored thereon instructions). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. The well-known

computer readable mediums listed in the reply filed on August 25, 2005 are articles of manufacture. The scope applicant's claims includes tangible and intangible mediums.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 44, 45, 52, 58-60 and 73-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Leeds, USPN 6,393,465 (hereafter referred to as Leeds).

6. Regarding claims 44, 58 and 73, Leeds discloses system for selectively accepting an electronic message having a sender address and sent from a remote host to one or more recipient addresses (column 6, lines 36-65), the system comprising an address verification filter determining whether the sender address exists at an authorized mailhost for a domain of the sender address without sending an electronic mail message to the sender address (column 5, lines 19-28) and accepting the electronic message if the sender address exists (column 8, lines 1-23).

7. Regarding claims 52, 59 and 74, Leeds further discloses the address verification filter not accepting the electronic message if the sender address is determined not to exist (column 4, lines 37-59 and column 8, lines 1-12).

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8. Regarding claims 45, 60 and 75, Leeds further discloses the address verification filter establishing a test connection from the system to the authorized mailhost for the sender address, sending a test protocol transaction specifying the sender address to the authorized mailhost, and determining if the authorized mailhost affirmatively accepts the sender address as a recipient (column 4, lines 37-59 and column 5, line 63 - column 6, line 51).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 86-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds in view of Barchi, USPN 6,507,866 B1 (hereafter referred to as Barchi).

11. Regarding dependent claim 86, Leeds taught a test protocol involving a message (column 5, lines 21-23). Leeds does not specifically teach the protocol transaction includes a simple mail transfer protocol MAIL command and a simple mail transfer protocol RCPT command. Barchi taught a mail protocol transaction includes a simple mail transfer protocol MAIL command and a simple mail transfer protocol RCPT command (column 1, lines 42-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Barchi's SMTP protocol in

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Leeds system for testing sender addresses would have expanded system utility. The motivation would have been use a standard protocol and promote greater system utility.

12. Regarding dependent claim 87, Barchi taught the MAIL From command specifies a complete e-mail address in the local domain (column 1, lines 42-55).

13. Regarding dependent claim 88, Barchi taught the MAIL From command specifies the null address "<>" (part of protocol).

14. Regarding dependent claim 89, Barchi taught said determination is made based upon the authorized mailhost's numeric response to the RCPT command (part of protocol to include a number with RCPT command).

15. Regarding dependent claim 90, Barchi taught said determination is made based upon the authorized mailhost's numeric response to a DATA command (part of protocol to include a number with DATA command).

Response to Arguments

16. Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive.

17. Applicant argues – "Neither Drummond nor Leeds suggest that less than an entire e-mail can be sent."

a. That is not what applicant's claim language recites, the claim language recites "without sending an electronic mail message". Leeds taught sending other types of messages to test for a sender address (sender , column 5, lines 19-29).

18. Applicant argues – “In contrast, the protocol interaction used by the present invention are distinct from delivery status notifications and are necessary if the sender address exists and is configured to send e-mail.

b. The protocol interactions disclosed by Leeds are protocol interactions used to determine whether a sender address exists and is configured to send email, see column 5, lines 23-29. Discrete protocol commands and messages are used to determine whether a sender address exists. Therefore, applicant's statements concerning the teachings in Leeds are in error as explained above.

19. Applicant argues – “Indeed, Leeds does not even mention the term ‘domain’, except when mentioning the title of a prior art document.”

c. Leeds taught a test protocol using the UNIX “whois” command to determine if a host or site (i.e. a domain) exists, see column 5, lines 23-25.

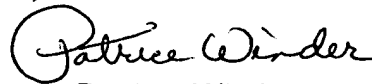
Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Patrice Winder". The signature is written in black ink and is positioned above the printed name and title.

Patrice Winder
Primary Examiner
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November 14, 2005